

REMARKS

Applicant proposes amending claims 1, 11, 17, 22, and 29. Claims 1-26, 28-33, and 35-37 are pending in this application.

In the Final Office Action,¹ the Examiner rejected claims 22, 23, 25, 26, 28-30, 32, 33, and 35 under 35 U.S.C. § 103(a) as obvious over Chern et al. (U.S. Patent No. 6,381,465) in view of Angles et al. (U.S. Patent No. 5,933,811); rejected claims 1, 2, 5, 8-11, 13, 14, 16, 17, 21, 36, and 37 under 35 U.S.C. § 103(a) as obvious over Chern in view of Lee et al. (U.S. Patent No. 6,829,475) and in further view of Angles; rejected claim 3 under 35 U.S.C. § 103(a) as obvious over Chern in view of Lee, Angles, and Atsmon et al. (U.S. Patent No. 6,607,136); rejected claims 4 and 19 under 35 U.S.C. § 103(a) as obvious over Chern in view of Lee, Angles, and Maxwell (U.S. Patent No. 6,470,181); rejected claims 6, 15, and 20 under 35 U.S.C. § 103(a) as obvious over Chern in view of Lee, Angles, and Bezos et al. (U.S. Patent No. 6,029,141); rejected claims 7, 12, and 18 under 35 U.S.C. § 103(a) as obvious over Chern in view of Lee, Angles and Matsumoto et al. (U.S. Patent No. 6,484,946); and rejected claims 24 and 31 under 35 U.S.C. § 103(a) as obvious over Chern in view of Angles and in further view of Maxwell.

I. REJECTION OF CLAIMS 22, 23, 25, 26, 28-30, 32, 33, AND 35

Applicant respectfully traverses the rejection of claims 22, 23, 25, 26, 28-30, 32, 33, and 35 under 35 U.S.C. § 103(a) as obvious over Chern in view of Angles. To

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must demonstrate each of three requirements. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8th ed. 2001). Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02 (8th ed. 2001). Moreover, each of these requirements must be found in the prior art, not in applicant's disclosure. See M.P.E.P. § 2143 (8th ed. 2001).

Claim 22, as proposed to be amended, recites a method for wireless device advertising including, among other steps, "paying a fee to the wireless advertising service, wherein a portion of the fee goes to a user of the registered wireless device as remuneration once the user has accepted a predetermined number of advertising messages sent to the registered wireless device." Chern and Angles, individually or in combination, do not disclose or suggest at least this step of claim 22.

In the Final Office Action, the Examiner admits Chern does not teach "remunerating users for accepting the advertising messages" or that "a portion of the fee paid for said advertising service goes to the user." See Final Office Action, page 3. However, the Examiner contends Angles compensates for these deficiencies of Chern. Notwithstanding the Examiner's characterization of Angles, Angles nevertheless does not teach or suggest all of the elements of claim 22, as proposed to be amended.

For example, Angles teaches that its system may “pay an Internet provider 34 based on the number of advertisements viewed by its consumers.” See col. 16, lines 31-33. In the alternative, Angles teaches paying “a consumer for viewing advertisements by crediting a consumer’s Internet provider account.” See col. 16, lines 35-37. However, Angles does not disclose or suggest at least “paying a fee to the wireless advertising service, wherein a portion of the fee goes to a user of the registered wireless device as remuneration once the user has accepted a predetermined number of advertising messages sent to the registered wireless device,” as recited in claim 22. For at least this reason, Chern and Angles, alone or in combination, do not disclose or suggest claim 22. Accordingly, a *prima facie* case of obviousness has not been established. Therefore, the Examiner should withdraw the rejection of claim 22 under 35 U.S.C. § 103(a).

Independent claim 29, while of a different scope from claim 22, includes recitations similar to those discussed above with regard to claim 22. Accordingly, Chern and Angles, alone or in combination, also do not disclose or suggest all elements of claim 29 and fail to establish a *prima facie* case of obviousness. Therefore, the Examiner should also withdraw the rejection of claim 29 and the rejection of dependent claims 23, 25, 26, 28, 30, 32, 33, and 35, which depend from one of allowable independent claims 22 and 29.

II. REJECTION OF CLAIMS 1, 2, 5, 8-11, 13, 14, 16, 17, 21, 26, AND 27

Applicant respectfully traverses the rejection of claims 1, 2, 5, 8-11, 13, 14, 16, 17, 21, 36, and 37 under 35 U.S.C. § 103(a) as obvious over Chern in view of Lee and in further view of Angles.

Claim 1, as proposed to be amended, recites a method of wireless device advertising including, among other steps, “remunerating a user of the registered wireless device once the user has accepted a predetermined number of advertising messages sent to the registered wireless devices device.” As discussed above, Chern and Angles, whether taken alone or in combination, do not disclose or suggest at least this step. Furthermore, Lee does not compensate for the above-described deficiency of Chern and Angles.

In the Final Office Action, the Examiner alleges Lee “teaches a method and system for transmitting advertising messages to wireless devices wherein prior to receiving said advertising messages, a user has to register his/her wireless device.” See Final Office Action, page 5. Even assuming the Examiner’s allegations were correct, which Applicant does not concede, Lee does not disclose or suggest at least “remunerating a user of the registered wireless device once the user has accepted a predetermined number of advertising messages sent to the registered wireless devices device,” as recited in claim 1. For at least the above reasons, Chern, Lee, and Angles, whether taken alone or in combination, do not disclose or suggest claim 1. Accordingly, a *prima facie* case of obviousness has not been established. Therefore, the Examiner should withdraw the rejection of claim 1 under 35 U.S.C. § 103(a).

Independent claims 11 and 17, while of a different scope from claim 1 and each other, include recitations similar to those discussed above with regard to claim 1. Accordingly, Chern, Lee, and Angles, alone or in combination, also do not disclose or suggest claims 11 and 17. Accordingly, the Examiner should also withdraw the rejection of claims 11 and 17 under 35 U.S.C. § 103(a) and the rejection of dependent claims 2, 5, 8-10, 13, 14, 16, 21, 36, and 37, which depend from one of allowable independent claims 11 and 17.

III. REJECTION OF CLAIM 3

Applicant respectfully traverses the rejection of claim 3 under 35 U.S.C. § 103(a) as obvious over Chern in view of Lee, Angles, and Atsmon. Claim 3 depends from allowable claim 1, which includes a step of “remunerating a user of the registered wireless device once the user has accepted a predetermined number of advertising messages sent to the registered wireless devices device.” As discussed above, Chern, Lee, and Angles, whether taken alone or in combination, do not disclose or suggest at least this step. Furthermore, Atsmon does not compensate for the above-described deficiency of Chern, Lee, and Angles.

In the Final Office Action, the Examiner alleges Atsmon “teaches a method for interacting with a broadcast media (TV or PC) to receiver coupons and sales special offers, wherein users receive incentive points as a reward for watching [the] advertisement.” See page 9. Even assuming the Examiner’s allegations were correct, which Applicant does not concede, Atsmon does not disclose or suggest at least “remunerating a user of the registered wireless device once the user has accepted a

predetermined number of advertising messages sent to the registered wireless devices device," as recited in claim 1. For at least the above reasons, Chern, Lee, Angles, and Atsmon, whether taken alone or in combination, do not disclose or suggest claim 3. Accordingly, a *prima facie* case of obviousness has not been established. Therefore, the Examiner should withdraw the rejection of claim 3 under 35 U.S.C. § 103(a).

IV. REJECTION OF CLAIMS 4 AND 19

Applicant respectfully traverses the rejection of claims 4 and 19 under 35 U.S.C. § 103(a) as obvious over Chern in view of Lee, Angles, and Maxwell. Claims 4 and 19 respectively depend from allowable claims 1 and 17. As discussed above, Chern, Lee, and Angles do not disclose or suggest all of the elements of claims 1 and 17. Furthermore, Maxwell does not compensate for the above-described deficiency of Chern, Lee, and Angles.

In the Office Action, the Examiner alleges Maxwell "teaches a method and system for delivery of advertising messages to cell phones, wherein an advertiser pays a portion of the airtime cost of a call originated by a mobile subscriber after that subscriber has listened to a recorded advertisement." See Final Office Action, page 10. Even assuming the Examiner's allegations were correct, which Applicant does not concede, Maxwell does not compensate for the deficiencies of Chern, Lee, and Angles discussed above. Accordingly, Chern, Lee, Angles, and Maxwell, whether taken alone or in combination, do not disclose or suggest claims all elements required by claims 4 and 19. Therefore, a *prima facie* case of obviousness has not been established and the Examiner should withdraw the rejection of claims 4 and 19 under 35 U.S.C. § 103(a).

V. REJECTION OF CLAIMS 6, 15, AND 20

Applicant respectfully traverses the rejection of claims 6, 15, and 20 under 35 U.S.C. § 103(a) as obvious over Chern in view of Lee, Angles, and Bezos. Claims 6 and 15, and claim 20 respectively depend from allowable claims 1 and 17. As discussed above, Chern, Lee, and Angles do not disclose or suggest all of the elements of claims 1 and 17. Furthermore, Bezos does not compensate for the above-described deficiency of Chern, Lee, and Angles. In the Final Office Action, the Examiner alleges Bezos “teaches a method and system for an internet-based customer referral system, wherein registered users receive commissions for referring other users to [a] merchant’s site.” See page 10. Even assuming the Examiner’s allegations were correct, which Applicant does not concede, Bezos does not compensate for the deficiencies of Chern, Lee, and Angles discussed above. Accordingly, Chern, Lee, Angles, and Bezos, whether taken alone or in combination, do not disclose or suggest all elements required by claims 6 and 15, and claim 20. Therefore, a *prima facie* case of obviousness has not been established and the Examiner should withdraw the rejection of claims 6, 15, and 20 under 35 U.S.C. § 103(a).

VI. REJECTION OF CLAIMS 7, 12, AND 18

Applicant respectfully traverses the rejection of claims 7, 12, and 18 under 35 U.S.C. § 103(a) as obvious over Chern in view of Lee, Angles and Matsumoto. Claims 7 and 12, and claim 18 respectively depend from allowable claims 1 and 17. As discussed above, Chern, Lee, and Angles do not disclose or suggest all of the elements of claims 1 and 17. Furthermore, Matsumoto does not compensate for the above-

described deficiency of Chern, Lee, and Angles. In the Final Office Action, the Examiner alleges Matsumoto “teaches a method for accessing and displaying information related to [an] electronic money transaction, wherein a user is able to ... [access] his account to review confidential information, including points accumulated and redeemed at participating merchants.” See page 11. Even assuming the Examiner’s allegations were correct, which Applicant does not concede, Matsumoto does not compensate for the deficiencies of Chern, Lee, and Angles discussed above. Accordingly, Chern, Lee, Angles, and Matsumoto, whether taken alone or in combination, do not disclose or suggest all elements required by claims 7 and 12, and claim 18. Since a *prima facie* case of obviousness has not been established, the Examiner should withdraw the rejection of claims 7, 12, and 18 under 35 U.S.C. § 103(a).

VII. REJECTION OF CLAIMS 24 AND 31

Applicant respectfully traverses the rejection of claims 24 and 31 under 35 U.S.C. § 103(a) as obvious over Chern in view of Angles and in further view of Maxwell. Claims 24 and 31 respectively depend from allowable claims 22 and 29, the elements of which are neither disclosed nor suggested by Chern and Angles. Further, as noted above in the discussion of claims 4 and 19, Maxwell also does not make up for the deficiencies of Chern and Angles. Accordingly, Chern, Angles, and Maxwell, whether taken alone or in combination, do not disclose or suggest all of the elements required by claims 24 and 31. Sine a *prima facie* case of obviousness has not been established,

the Examiner should withdraw the rejection of claims 24 and 31 under 35 U.S.C. § 103(a).

CONCLUSION

Applicant respectfully requests that the Examiner enter this Amendment under 37 C.F.R. § 1.116, placing the pending claims in condition for allowance. Applicant submits that the proposed amendments do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicant respectfully points out that the Final Office Action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the Amendment would allow Applicant to reply to the final rejections and place the application in condition for allowance. Finally, Applicant submits that the entry of the Amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicant requests the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: February 24, 2006

By: Anthony J. Lombardi
Anthony J. Lombardi
Reg. No. 53,232